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## NOTICE OF ALLOWANCE AND FEE(S) DUE

24498 7590 01/20/2010

Robert D. Shedd, Patent Operations  
THOMSON Licensing LLC  
P.O. Box 5312  
Princeton, NJ 08543-5312

EXAMINER

WITZENBURG, BRUCE A

ART UNIT

PAPER NUMBER

2166

DATE MAILED: 01/20/2010

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,330	08/23/2006	Louis Robert Litwin	PU030287	8336

TITLE OF INVENTION: DISCUSSION ASSOCIATION FOR E-MAIL

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	04/20/2010

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

**THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

## HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

# **PART B - FEE(S) TRANSMITTAL**

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop **ISSUE FEE**  
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**INSTRUCTIONS:** This form should be used for transmitting the **ISSUE FEE** and **PUBLICATION FEE** (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

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 THOMSON Licensing LLC  
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 Princeton, NJ 08543-5312

## **Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop **ISSUE FEE** address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,330	08/23/2006	Louis Robert Litwin	PU030287	8336
TITLE OF INVENTION: DISCUSSION ASSOCIATION FOR E-MAIL				

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nonprovisional	NO	\$1510	\$300	\$0	\$1810	04/20/2010

EXAMINER	ART UNIT	CLASS-SUBCLASS
WITZENBURG, BRUCE A	2166	707-100000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.  
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a **Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 \_\_\_\_\_  
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 \_\_\_\_\_  
 3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY AND STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee  
☐ Publication Fee (No small entity discount permitted)  
☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.  
☐ Payment by credit card. Form PTO-2038 is attached.  
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims **SMALL ENTITY** status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming **SMALL ENTITY** status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_ Date \_\_\_\_\_  
 Typed or printed name \_\_\_\_\_ Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.**

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10/590,330

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Louis Robert Litwin

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Robert D. Shedd, Patent Operations  
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EXAMINER

WITZENBURG, BRUCE A

ART UNIT

PAPER NUMBER

2166

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## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 62 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 62 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

**Notice of Allowability****Application No.**

10/590,330

**Applicant(s)**

LITWIN ET AL.

**Examiner**

BRUCE A. WITZENBURG

**Art Unit**

2166

**- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendments received 9/10/2009.
2. ☒ The allowed claim(s) is/are 1, 4-11, 13-16, 18 and 20.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of the:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.  
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached  
1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.  
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.  
**Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

/Etienne P LeRoux/  
Primary Examiner, Art Unit 2161

/Bruce A Witzenburg/  
Examiner, Art Unit 2166

### DETAILED ACTION

1. Claims 1, 4-11, 13-16, 18 and 20 are pending in the instant application.

### EXAMINER'S AMENDMENT

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
3. The application has been amended as follows:
  1. (Currently amended) A method for organizing e-mail messages comprising the steps of:
    - providing a direct email-to-email association option in an email program;
    - indicating at least one first e-mail message in a user mailbox;
    - associating the at least one first e-mail message with a second e-mail message by enabling the association option, wherein said step of associating further comprises enabling an options list to appear with respect to the at least one first e-mail message, said options list including at least an associate option, a show associations option, and a hide associations option;
    - selecting the associate option on the options list; and

selecting the second e-mail message, wherein the second e-mail message is caused to be automatically associated to the at least one first e-mail message to form an associated group of e-mails; and  
forming an associated group of e-mails in the user mailbox comprising at least two or more associated e-mail[[s]] messages;  
creating a reply email to at least one of the associated group of e-mails; and  
selecting at least one of the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show the associated group of emails to a recipient.

2. (Cancelled)

3. (Cancelled)

4. (Currently amended) The method of claim 1, wherein the reply e-mail shows its associated e-mail[[s]] messages to the recipient when the show associations option is selected.

5. (Currently amended) The method of claim 1, wherein the reply e-mail hides its associated group of e-mail[[s]] messages from the recipient when the hide associations option is selected.

6. (Original) The method of claim 1, further comprising the step of providing a collapsability and expandability feature for the associated group.

7. (Original) The method of claim 6, further comprising the step of providing a first graphical indicator for indicating when the associated group is expanded and a second graphical indicator for indicating when the associated group is collapsed.

8. (Currently amended) The method of claim 1, further comprising the step of providing e-mail operations for performing on the associated group of e-mail[[s]] messages.

9. (Currently amended) A method for organizing e-mail messages comprising the steps of:

creating a user-defined discussion topic heading;

displaying said discussion topic heading as a separate field in a mailbox entry in at least one of the user's mailboxes;

associating at least one e-mail message to the user-defined discussion topic heading to form an associated e-mail-to-topic group;

~~controlling whether at least one of the user-defined discussion topic heading and~~  
~~at least one~~ an associated email message is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient; and

showing ~~at least one of the discussion topic heading and the~~ associated e-mail[[s]] messages of the reply e-mail to the recipient if the show associations option is selected.

10. (Previously presented) The method of claim 9, wherein the step of associating further comprises the steps of:

enabling an options list to appear with respect to the user-defined discussion topic heading;

selecting an associate option on the options list; and

indicating at least one e-mail message; wherein the at least one e-mail is caused to be automatically associated to the user-defined discussion topic heading to form the associated e-mail-to-topic group.

11. (Previously presented) The method of claim 10, further comprising the steps of providing a show associations and a hide associations option on the options list; and selecting at least one of the show associations option and the hide associations option on a reply e-mail message to be sent to a recipient.

12. (Canceled)

13. (Previously presented) The method of claim 11, further comprising the step of hiding at least one of the discussion topic heading and associated e-mails of the reply e-mail message to the recipient if the hide associations option is selected.

14. (Original) The method of claim 9, further comprising the step of providing a collapsability and expandability feature for the associated e-mail-to-topic group.

15. (Currently amended) An e-mail system comprising:

an associate feature for providing at least one of a direct email-to-email or email-to- topic association option in an email program by enabling a user to directly link an email message to another email message or to a topic displayed as a field in a mailbox entry, thereby organizing e-mail messages to form at least one of an associated group of e-mail[[s]] messages or an associated e-mail-to-topic group in at least one of the user's mailboxes, wherein the associated group of e-mail[[s]] messages is formed by the user causing an options list to appear with respect to at least one first e-mail message, selecting an associate feature from said options list, and selecting a second e-mail message for causing the second e-mail message to be automatically associated to the at least one first e-mail message to form the associated group of e-mail[[s]] messages, wherein the options list further comprises a show associations feature and a hide associations feature; and

a reply email created for at least one of the associated group of e-mails, said reply e-mail being configured to show associations the associated group of email[[s]] messages to a recipient.

16. (Previously presented) The system of claim 15, wherein the options list is provided with respect to each e-mail message, said options list including said associate feature.

17. (Cancelled)

18. (Previously presented) The system of claim 16, wherein the associated e-mail-to-topic group is formed by creating a user-defined discussion topic heading, causing the options list to appear with respect to at least one e-mail message, selecting the associate feature from said options list, and indicating the discussion topic heading, wherein the at least one e-mail message is caused to be automatically associated to the discussion topic to form the associated e-mail-to-topic group and said discussion topic heading appears as an additional field in said at least one e-mail message.

19. (Cancelled)

20. (Original) The system of claim 15, further comprising an auto-process feature for automatically parsing a received e-mail to search for an existing discussion thread,

wherein if an existing discussion thread is found, the received e-mail is automatically associated to the discussion thread.

***Allowable Subject Matter***

4. Claims 1, 4-11, 13-16, 18 and 20 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record is "Microsoft Outlook 2003, Advanced Information Management" Hereafter "Outlook;" Agrawal et al. (US 6,592,627) hereafter "Agrawal;" and Rosenschein et al. (US 6,341,306) hereafter "Rosenchein." The prior art of record does disclose various ways to associate and sort documents. These include an automatic association of objects based on lexical information as disclosed by Rosenchein, automatic association of email based on lexical and context information received as disclosed by Agrawal, and category and information labeling within a flagging context which the label is available to be passed to a recipient if desired. While all of the above are operable to sort and associate email messages, none are capable of creating a thread through association in a GUI and operate to make that full association automatically upon request to a recipient. While Outlook does disclose label information being potentially passed to a recipient, passing the entirety of previous emails in the user created thread is not enabled by any of the prior art. Because thread creation for the most part has been limited not to include user-created thread boundaries, and because propagation of email

association based on user preference is rare in the art with propagation of the associated emails themselves being undisclosed, the aspect of propagating emails from a user defined group of emails is believed to be novel and overcome the prior art in the field. Because the invention improves usability of email interfaces it is believed pertain to both useful and allowable subject matter.

The dependent claims which are definite and enable by the specification and being further limiting to the independent claims are also allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

As an additional examiner's note, claim 12 was canceled by the examiner as it did not further limit claim 11. The limitation claim 12 recited was present nearly verbatim within claim 10, on which 11 was already dependant.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRUCE A. WITZENBURG whose telephone number is (571)270-1908. The examiner can normally be reached on M-F 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruce A Witzenburg/

Examiner, Art Unit 2166

/Etienne P LeRoux/

Primary Examiner, Art Unit 2161